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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/339,605 | 06/24/1999 | DAVID L. PATTON | 79296F-P | 2805 |

1333 7590 09/10/2002

PATENT LEGAL STAFF
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EXAMINER

WALLERSON, MARK E

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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2622

DATE MAILED: 09/10/2002

5

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/339,605

Applicant(s)
Patton et al

Examiner
Mark Wallerson

Art Unit
2622



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on May 31, 2002
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 18-20 and 28 is/are allowed.
- 6) ☒ Claim(s) 1-17 and 21-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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Part III DETAILED ACTION

Notice to Applicant(s)

1. This action is responsive to the following communications: amendment filed on **5/31/2002.**

2. This application has been reconsidered. Claims 1-28 are pending.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

4. Claims 1, 2, 3, ~~4, 5~~, 6, 7, 11, ~~12, 13, 14, 15~~, ~~21, 22, 23, 24, 26, and 27~~ are rejected under 35 U.S.C. 102(e) as being anticipated by Nelson et. al. (hereinafter referred to as Nelson) (U. S. 6,132,024).

With respect to claims 1, 2, 4, 5, 7, 15, 21, 22, 23, and 24, Nelson discloses a method for making a digital print comprising the steps of obtaining a digital image file for printing by a printer (receiving text or images) (column 2, lines 3-6); printing the image onto media using a digital printer (column 3, lines 20-25), and printing a coordinate system (positional-calibration indicia) on

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the media over the image (which reads on overprinting the invisible ink over the visible ink) (column 4, lines 21-24) that is not visible to the human eye separate from the printing of the image (column 4, lines 21-31), the coordinate system being capable of locating a specific area on the print (column 2, lines 22-28).

With respect to claims 3, 6, 26, and 27, Nelson discloses that the coordinate system is printed over the image (column 4, lines 21-24).

With regard to claims 11 and 13 Nelson discloses an inkjet printer (column 6, lines 7-11).

With respect to claims 12 and 14 Nelson discloses a printer comprising a first mechanism for printing a visible image on the media (column 3, lines 20-25) and a second mechanism for printing a coordinate system (positional-calibration indicia) that is not visible to the human eye (column 3, lines 26-30).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims ~~8~~ 9, 10, ~~16~~, and ~~17~~ rejected under 35 U.S.C. 103(a) as being unpatentable over Nelson in view of Hakamatsuka et al. (hereinafter referred to as Hakamatsuka) (U. S. 5,410,642).

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With respect to claim 8, Nelson differs from claim 8 in that he does not clearly disclose additional data which is not visible to the human eye under normal viewing conditions printed on the same side as the image.

Hakamatsuka discloses printing attribute information (16) which is not visible to the human eye under normal viewing conditions (in infrared ink) along with other information (column 7, lines 14-29). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Nelson wherein additional data which is not visible to the human eye under normal viewing conditions would be printed on the same side as the image. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Nelson by the teaching of Hakamatsuka in order to increase the amount of information that the user may place on the document.

With respect to claims 9 and 10, Nelson discloses that the print is made on paper (column 1, lines 40-45).

With regard to claims 16 and 17, Nelson differs from claims 16 and 17 in that he does not clearly disclose that the coordinate system is provided in a specific pattern which corresponds to a different type media. Hakamatsuka discloses using different patterns for each lot (column 4, lines 26-34). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Nelson wherein the coordinate system is provided in a specific pattern which corresponds to a different type media. It would have been obvious to one of ordinary skill

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in the art at the time of the invention to have modified Nelson by the teaching of Hakamatsuka in order to improve the image processing system.

Allowable Subject Matter

7. Claims 18-20, and 28 are allowed.

Response to Arguments

8. Applicant's arguments filed 5/31/2002 have been fully considered but they are not persuasive.

Applicant submits that Nelson does not disclose that the coordinate system is invisible to the human eye. The Examiner respectfully disagrees. Nelson clearly discloses in column 3, lines 35-36 that ink may be used that is invisible to people.

Applicant also submits that Nelson does not disclose that the coordinate system locates a specific or designated area on a print. Again, the Examiner disagrees. Nelson discloses automatically sensing printed image details (column 2, lines 8-11) and registering image components in relation to a preprinted grid (column 2, lines 20-24).

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

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A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Wallerson whose telephone number is (703) 305-8581.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, DC 20231

or faxed to:

(703) 872-9314 (for formal communications intended for entry)

(for informal or draft communications, such as proposed amendments to be discussed at an interview; please label such communications "PROPOSED" or "DRAFT")

or hand-carried to:

Crystal Park Two
2121 Crystal Drive
Arlington, VA.
Sixth Floor (Receptionist)

MARK WALLERSON
PRIMARY EXAMINER

Mark Wallerson